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EXAMINER

BERMAN, A

ART UNIT

PAPER NUMBER

1619

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12

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/277,226

Applicant(s)

BARA ET AL.

Examiner

Alysia Berman

Art Unit

1619

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2001.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 and 62-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-60 and 62-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 20) ☐ Other: _____

DETAILED ACTION

1. Receipt is acknowledged of the amendment and information disclosure statement filed April 13, 2001. Claims 21 and 50 have been amended. Claims 1-60 and 62-67 are pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The 35 U.S.C. 102(b) rejection of claims 12-14, 23, 25, 27-30, 32, 34-37, 39, 40, 42-50, 56-60 and 62-66 over EP 0 819 426 A2 (426) is withdrawn because it does not teach the specific viscosity of instant claim 12.

4. Claims 1, 2, 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0 374 332 (332).

This rejection is maintained for reasons of record in paper no. 7. EP '332 discloses a water-in-oil emulsion comprising a silicone oil, a solid wax, water and a polyoxyalkylene modified organopolysiloxane (abstract). For lipsticks and pressed powder cosmetic compositions (blusher, foundation, eyeshadow, etc.), see page 2, lines 15-19. For silicone oils corresponding to the compounds and formulas of claims 23-26 in an amount about 5% to 85% by weight of the total composition, see page 4, lines 6-

Art Unit: 1619

35. For non-silicone waxes, see page 4, lines 36-50. The amount of the oxyalkylenated silicone is preferably 0.2% to 10% by weight (page 4, lines 56-58). For pigments and fillers such as talc, mica, titanium dioxide, zinc oxide, titanium coated mica, bismuth oxychloride, etc. in an amount up to 50% by weight, see page 5, lines 9-22. The aqueous phase may contain alcohols such as ethanol and polyols (page 5, line 26). For amino acids and hydroxyacids, see page 5, lines 27-28. For silicone wax, hydrocarbon oils, vitamins, antioxidants, thickeners, UV absorbers, etc., see page 5, lines 29-36. For poly(C₁-C₂₀)alkylsiloxanes of claim 30 in an amount up to 5% by weight, see example 8 at page 11. For 0 to 14% by weight of a lower C₂-C₆ monoalcohol or polyol in the aqueous phase, see example 6 at pages 10-11. For active principles such as sodium chondroitin sulfate at 1.5%, see example 10 at page 12. For the amount of the aqueous phase and fatty phase, see all of the examples.

5. Claims 1, 2, 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0 331 833 (833).

This rejection is maintained for reasons of record in paper no. 7. EP '833 discloses water-in-oil emulsion compositions comprising one or more oxyalkylenated silicone, an aqueous phase and an oil phase containing an organic silicone resin (abstract). Silicone oils and non-silicone hydrocarbon based oils in an amount from 5 to 90% by weight are disclosed at page 7, lines 9-17. An organic silicone resin with the silicone units as in claim 38 are disclosed at page 7, lines 56-57. Silicone oils that correspond to the compounds and structures of claims 23-26 are disclosed at page 8, lines 29-52. The amount of oil, whether silicone, hydrocarbon based or mixtures, is from

Art Unit: 1619

5 to 90% by weight (page 9, lines 35-36). For polyols in the aqueous phase, see page 8, lines 53-57. For additional ingredients such as thickeners, antioxidants, UV absorbers, extracts from plants and animals, pigments, and active principles such as amino acids, see page 9, lines 5-16. For silicone gums, see page 9, lines 29-31. For pigments and fillers such as mica, talc, nylon, titanium dioxide, iron oxide, titanium coated mica and tar type dyes, see page 9, line 52 to page 10, line 2. For amounts of a lower C₂-C₆ monoalcohol or a polyol, aqueous phase and fatty phase, filler see the examples.

6. Properties such as molecular mass, viscosity and refractive index are inherent to the compounds and the composition comprising the compounds. A chemical composition and its properties are not inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP §2112.01. Burden is shifted to Applicant to show that the composition of EP '833 does not exhibit the properties instantly claimed.

7. Because the references are silent as to the shape of the fillers, it encompasses any shape including non-spherical. Claims reciting "an amount up to" and "from 0 to" as written do not require the components in the claims. The phrase "up to" includes zero as a lower limit. *In re Mochel*, 470 F2d. 638, 176 USPQ 194 (CCPA 1974). The addition of the oxyalkylenated silicone into the compositions inherently produces a composition with reduced transfer or migration, or inversely, increased staying power. The expression "comprising" permits the presence of other ingredients and does not preclude the presence of other ingredients, active or inactive, even in major amounts.

Art Unit: 1619

See Moleculon Research Corporation v CBS, Inc. 229 USPQ 805, *In re Baxter* 210 USPQ 795, 803.

8. Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0 819 426 A2 (426).

This rejection is maintained for reasons of record in paper no. 9.

Response to Arguments

9. Applicant's arguments filed April 13, 2001 have been fully considered but they are not persuasive.

10. Applicant argues that EP '332, EP '833 and EP '426 are all silent with respect to reducing or eliminating the transfer or migration of the composition and improving the staying power of the composition. All of these properties are considered to be equivalent. Firstly, it is noted that the method claims only require the step of adding an α,ω -substituted oxyalkylenated silicone to a composition. Any properties exhibited by the composition due to the addition of the silicone component are inherent and are not given patentable weight. All of the prior art references disclose adding a silicone as instantly claimed into cosmetic compositions. The compositions of the prior art contain the same components as instantly claimed in the same amounts and, therefore, inherently exhibit the same properties of improved staying power and reduced or eliminated transfer or migration of the composition. Burden is shifted to Applicant to show that the compositions of the prior art do not exhibit the instantly claimed properties.

EP '332 discloses at page 5, lines 42-45 that the composition of the prior art provides prolonged retainability of the cosmetic finish. Prolonged retainability is considered equivalent to improved staying power and reduced or eliminated transfer or migration. EP '833 discloses at page 3, lines 37-39 that the compositions of the prior art exhibit flexibility. The ability of a cosmetic composition to be flexible upon wearing provides it with the improved staying because it is less likely to crack or flake and come off. Therefore, the disclosure of flexibility of the composition is considered to encompass improved staying power and reduced or eliminated transfer or migration.

11. Applicant argues that EP '332, EP '833 and EP '426 are all silent with respect to the "effective amount" of the instantly claimed silicone. This argument was addressed in paper no. 9. The term "effective amount" is not quantitatively defined by the claims. Therefore, a reference that is silent as to the amount of a component inherently encompasses any amount including an "effective amount" to obtain any desired effect. This being said it is clear that both the prior art references disclose weight percents of the silicone that are either encompassed by or overlap the weight percent ranges of instant claims 10 and 11.

EP '332 discloses that the amount of polyoxalkylene modified organopolysiloxane is preferable from 0.2-10% by weight, which is encompassed by both weight percent ranges claimed in instant claims 10 and 11. EP '833 discloses at page 8, lines 19-21 that the amount of polyoxyalkylene modified organopolysiloxane is preferably 0.5-20% by weight, which is either encompassed by or overlaps the weight percent ranges of instant claims 10 and 11. EP '426 discloses in the abstract that the

Art Unit: 1619

polyoxyalkylenated silicones are contained in the emulsions in amounts from 0.1-20% by weight, which is either encompassed by or overlaps the weight percent ranges of instant claims 10 and 11.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 1-19, 23-60 and 62-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 819 426 A2 (426) in combination with EP 0 331 833 A1 (833).

This rejection is maintained for reasons of record in paper no. 9.

Art Unit: 1619

15. Claims 1-23, 25, 27-37, 39-60 and 62-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 819 426 A2 (426) in combination with US 5,593,680 (680).

This rejection is maintained for reasons of record in paper no. 9.

Response to Arguments

16. Applicant's arguments filed April 13, 2001 have been fully considered but they are not persuasive.

17. Applicant argues that EP '426 does not disclose the claimed silicone in combination with the specific components listed in claim 12. The components listed in claim 12 are a water-in-oil emulsion comprising an aqueous phase, a fatty phase comprising at least one silicone oil, a dyestuff (which is disclosed in the instant claims and specification as encompassing pigments as well as dyes), and at least one α,ω -substituted oxyalkylenated silicone. EP '426 discloses a water-in-oil emulsion comprising a polyoxyalkylenated silicone as instantly claimed (abstract), colorants, which encompasses dyestuffs as instantly claimed (page 2, lines 6-7) and silicone oils (page 7, lines 18-21).

18. Applicant argues that neither EP '426 nor EP '833 teach or suggest the viscosity of claim 12. Viscosity is an inherent property that is not given patentable weight. The compositions of the prior art containing the same components in the same amounts as instantly claimed inherently exhibit the same properties. Burden is shifted to Applicant to show that the emulsion of the prior art does not have the instantly claimed viscosity.

Additionally, it is within the skill in the art to adjust the amounts of components in the composition to obtain the desired viscosity. EP '426 teaches at page 5, lines 9-12 that an object of the invention is to provide w/o emulsions with low viscosity by using the polyoxyalkylenated silicones. EP '426 also teaches at page 8, lines 21-24 that adjusting the amount of water in the emulsions can either increase or decrease the viscosity depending on the desired product. The viscosity of the emulsion is not considered critical to the invention absent evidence of unexpected results.

19. Applicant argues that there would have been no motivation for one of ordinary skill in the art to modify EP '833 to omit a water-swellaable clay to obtain the presently claimed invention. The claims as written containing the open claim language "comprising" do not exclude a water-swellaable clay or any other additional components. Therefore, one would not need to modify the emulsion of EP '833 to obtain the instantly claimed emulsion.

20. Applicant argues that there is no motivation to combine EP '426 with US '680. US '680 is used merely to show that the dyes of instant claim 20 are known for use in cosmetic compositions. It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition which is to be used for the very same purpose. *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). The idea of combining them flows logically from their having been individually taught in the prior art. *In re Crockett*, 279 F.2d 274, 276-77, 126 USPQ 186, 188 (CCPA 1960). Both EP '426 and US '680 are directed to the same field of endeavor, cosmetics, and are directed to solving the same

Art Unit: 1619

problem, ease of application and pleasant feeling upon use. The motivation to use the dyes of US '680 in the composition of EP '426 is for the intended purpose of providing color to the compositions.

Conclusion

21. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Correspondence


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-4638. The examiner can normally be reached on Monday through Friday from 8:30 to 4:00.

Art Unit: 1619

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on 703-308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592 or 703-305-4456 for regular communications and 703-308-7922 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.


Alysia Berman
Patent Examiner
May 30, 2001


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